

REMARKS

Reconsideration of the present application is respectfully requested in light of the above amendments to the application and the following remarks.

Regarding the Claims

Claims 1-8 are withdrawn. Claims 9-13 have been amended to address the Examiner's objection and to correct minor grammatical and antecedent basis matters. No new matter has been added. Currently pending in the application, therefore, are Claims 9-13, of which Claim 9 is independent.

Claims 9-13 have been rejected under 35 U.S.C. §103(a) as being unpatentable over Libardet (U.S. 4,864,790) in view of Hirsch (U.S. 4,849,145) and Zegler et al. (U.S. 5,567,497), and further in view of Yoshimi et al. (U.S. 4,860,506).

Review of the Cited References**a. Liardet**

Liardet describes a leather tile comprising a decorative upper surface and an undulating lower surface, but no mention is made about holes through the two surfaces. Liardet fails to disclose, teach or suggest air exchange between the upper and lower area of the tile. It is not practicable to use Liardet's tiles in heated floor systems. Indeed, if the tiles of Liardet were used within heat exchanges the temperature gradient created would likely cause the slipping of the leather tile, because it is well known in the art that a leather object tends to fold or curl if subjected to high temperature.

b. Hirsch

Hirsch describes a process for the production of articles comprising at least one layer of leather and one layer of a synthetic resin connected to it. However, Hirsch's method relates to watchbands and similar wearable objects and so the technical problem intended to be solved is completely different in respect to the problem solved by the present invention. The apertures of Hirsch are intended for insertion of a tang as part of the clasp mechanism.

c. Zegler et al. (Zeglar™)

Zegler teaches how to attain a floor covering comprising a face layer that is "fusibly compatible" with and fused to lower backing layer. Zegler addresses the problem of having a floor covering that can be easily removed and substituted. Zegler does not disclose, teach or suggest a product with through holes suitable for connecting the upper and the lower layer to allow for air and heat passage.

d. Yoshimi

Yoshimi teaches a solid floor panel with raised support members for a floating floor of the kind. The main goal of Yoshimi is to reduce transmission of floor impact sounds by preventing compression and expansion of air under the floor panels. Yoshimi does not address the problem of allowing the air to flow in particular between a heated floor and the room where it is placed. Noise abatement by eliminating compression and expansion is a completely different technical issue from allowing air and heat flow through the structure and the problem or solution is not disclosed, taught or suggested by Yoshimi.

The structure proposed in Yoshimi does not disclose, teach or suggest the use of flexible materials such as leather for attaining the floating floor. In particular, it is not possible to put a leather layer on the supporting members described in Yoshimi because of the lack of rigidity of that kind of material. For this reason the panels in Yoshimi have to be made of rigid material, i.e., wood (see, Yoshimi, Example I). Furthermore, the panel described in the document has the function to support a decorative layer such as a carpet, which covers the holes, and not to act as decorative layer itself.

Prima Facie Case of Obviousness

To establish *prima facie* obviousness of a claimed invention, all claim limitations must be taught or suggested by the prior art. *In re Roy*, 490 F.2d 981, 180 U.S.P.Q. 580 (C.P.A. 1974).

When an obviousness determination is based on multiple prior art references, there must be a showing of some "teaching, suggestion, or reason" to combine the references. Gambro Lundia AB v. Baxter Healthcare Corp., 110 F.3d 1573, 1579, 42 USPQ2d 1378, 1383 (Fed. Cir. 1997) (also noting that the "absence of such a suggestion to combine is dispositive in an obviousness determination"). Whether motivation to combine the references was shown we hold a question of fact. See In re Dembiczak, 175 F.3d 994, 1000, 50 USPQ2d 1614, 1617 (Fed. Cir. 1999) ("[P]articular factual findings regarding the suggestion, teaching, or motivation to combine serve a number of important purposes . . .") (emphasis added); Monarch Knitting, 139 F.3d at 881-83, 886, 45 USPQ2d at 1982, 1985 (treating motivation to combine issue as part of the scope and content of the prior art and holding that genuine issues of fact existed as to whether one of ordinary skill in the art would have been motivated to combine the references in question).

Evidence of a suggestion, teaching, or motivation to combine prior art references may flow, inter alia, from the references themselves, the knowledge of one of ordinary skill in the art, or from the nature of the problem to be solved. See Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617. Although a reference need not expressly teach that the disclosure contained therein should be combined with another, see Motorola, Inc. v. Interdigital Tech. Corp., 121 F.3d 1461, 1472, 43 USPQ2d 1481, 1489 (Fed. Cir. 1997), the showing of combinability, in whatever form, must nevertheless be "clear and particular." Dembiczak, 175 F.3d at 999, 50 USPQ2d at 1617.

Obviousness can only be established by combining or modifying the teachings of the prior art to produce the claimed invention when there is some teaching, suggestion, or motivation to do so found either in the references themselves or in the knowledge generally available to one of ordinary skill in the art. ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 2221 U.S.P.Q. 929, 933 (C.A.F.C. 1984).

Applicant respectfully submits that the claims as amended are distinguishable over the cited combination of references. None of the references, singly or in combination, disclose a tile comprising a layer of leather having at least one through hole, and a layer of plastic resin integrally supported to said layer of leather and having also at least a through hole, said at least

one shallow groove and said at least one hole being suitable for allowing a convective air flow through the tile. The Examiner attempts to create a case of obviousness by combining references that (1) do not address the problems addressed by the present invention, (2) use different materials from those in the present invention as claimed, and (3) function differently from the claimed invention.

Specifically, the tiles of Liardet are not suitable for use in heated floor systems. The process of Hirsch is used for watch bands and the apertures are present for use with the clasp and not related to air flow through. Watch bands and floor tiles are nonanalogous art with respect to the air and heat flow through aspect. Zegler does not disclose apertures. Yoshimi discloses a solid plywood floor panel raised on supports and is focused on prevention of air compression and expansion for noise reduction. There is no suggestion or motivation in any of these references to combine some or all of them to provide a flexible leather tile of the present invention as claimed. It would not have been obvious to combine the teachings of the cited references and, therefore, Applicant respectfully submits that the Claims as amended are patentable over the cited art.

Some amendments and remarks contained in this document, or in other documents filed or to be filed with the US Patent Office in this case or related cases, may in the future be deemed, by a court of law or government agency of competent jurisdiction, to be narrowing amendments and/or related to patentability. Accordingly, the public is hereby advised that the applicant: (a) intends to relinquish only that claim coverage which is clearly, explicitly, precisely and unequivocally stated to be relinquished; (b) does not intend to relinquish any other claim coverage; (c) reserves the right to assert that any such amendments and/or remarks are not narrowing and/or are not related to patentability; and (d) intends to fully assert the full range of equivalents, under the Doctrine of Equivalents and otherwise, which are presently known or which may become known in the future, for each and every element of each and every claim, and for each and every claim.

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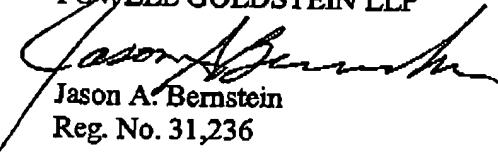
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Should the Examiner have questions or suggestions which will put this application in line for allowance, he or she is requested to contact the undersigned attorney.

Respectfully submitted,

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